



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. Box 1450  
ALEXANDRIA, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

PILLSBURY WINTHROP SHAW PITTMAN, LLP  
P.O. BOX 10500  
MCLEAN VA 22102

**COPY MAILED**

JUN 02 2006

**OFFICE OF PETITIONS**

In re Application of :  
Metcalf :  
Application No. 08/749,766 :  
Filing Date: November 20, 1996 : Decision on Petition for  
Attorney Docket No.: 027966-0311337 : Patent Term Extension  
For: SOUND SYSTEM AND METHOD FOR :  
CAPTURING AND REPRODUCING :  
SOUNDS ORIGINATING FROM A :  
PLURALITY OF SOUND SOURCES :  
:

The above-identified application has been forwarded to the undersigned for consideration on a petition for patent term extension entitled "Petition under 37 CFR 1.181 to review a Determination of the Length of the Patent Term Extension under 37 CFR 1.701," received on March 23, 2006.

The petition is GRANTED.

Petitioner notes that the Notice of Allowance dated January 23, 2006, in the above-identified application incorrectly stated that the patent term extension is 537 days. Petitioner states that applicant is entitled to 5 years of patent term extension or alternatively 1,518 days of patent term extension, not the 537 days of extension as stated in the Notice of Allowance.

35 U.S.C. § 154(b) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000, and, as amended by the "American Inventors Protection Act of 1999," enacted November 29, 1999, as part of Public Law 106-113, for those delays and others in applications filed on or after May 29, 2000

A first Notice of Appeal was filed in the above-identified application on August 25, 2000. On May 2, 2003, the Board of Appeals and Interferences reversed the decision of the examiner in the above-identified application. Since the above-identified application was filed after June 7, 1995, there is no terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review, and issuance of the application as a patent was delayed due to appellate review resulting in a reversal of an adverse decision of patentability, the patent to issue from the application is entitled to an extension of the patent term. The period of delay in the above-identified application is the period beginning on August 25, 2000, the date that the Notice of Appeal was filed and ending on May 2, 2003, the date of the final decision in favor of the applicant. Three years after the

earliest effective filing date of the application is November 20, 1999. Accordingly, the period of extension is not required to be reduced pursuant to 37 CFR 1.701(d)(1) by the amount of time prior to three years after the filing date of the application. As a result, the first period of extension is **981 days**, the period from August 25, 2000 to May 2, 2003, including the beginning and end dates.

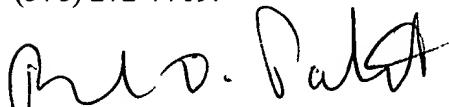
A second Notice of Appeal was filed in the above-identified application on May 14, 2004. On October 31, 2005, the Board of Appeals and Interferences reversed the decision of the examiner in the above-identified application. Since the above-identified application was filed after June 7, 1995, there is no terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review, and issuance of the application as a patent was delayed due to appellate review resulting in a reversal of an adverse decision of patentability, the patent to issue from the application is entitled to an extension of the patent term. The period of delay in the above-identified application is the period beginning on May 13, 2004, the date that the Notice of Appeal was filed and ending on October 31, 2005, the date of the final decision in favor of the applicant. Three years after the earliest effective filing date of the application is November 20, 1999. Accordingly, the period of extension is not required to be reduced pursuant to 37 CFR 1.701(d)(1) by the amount of time prior to three years after the filing date of the application. As a result, the second period of extension is **537 days**, the period from May 13, 2004 to October 31, 2005, including the beginning and end dates.

Petitioner's argument that the period of extension should be from August 25, 2000 to October 31, 2005, is not persuasive, as a final decision in favor of Applicant by the BPAI was mailed on May 2, 2003. The mailing of the final decision in favor of Applicant on May 2, 2003 ends the period that was started by the Notice of Appeal. As a result, the period of extension is **1,518 days**, the period from August 25, 2000 to May 2, 2003 and the period from May 13, 2004 to October 31, 2005, including the beginning and end dates.

After mailing of this decision, the above-identified application will be forwarded to Office of Publications for further processing. The patent, if issued, will include an indication that the patent term is extended by **1,518 days**.

Petitioner's deposit account has not been charged a petition fee.

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.



Mark O. Polutta  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy